

BRIEF IN SUPPORT OF PETITION

Opinions of the Courts Below

The opinion of the district court appears in the certified transcript of record at pages 417-424 and is reported in 56 F. Supp. 979.

The majority opinion of the circuit court of appeals appears at pages 486-492 of the transcript, and the dissenting opinion of Judge Parker appears at pages 492-497. They are reported at 149 F. 2d. 87.

Jurisdiction

1. The case is within the judicial power of the United States courts because it is an action brought under the Declaratory Judgments Act (Section 274-D of the Judicial Code; 28 U. S. C. § 400) for a declaration upon the question of validity and infringement of United States Letters Patent, a question arising under the Constitution and laws of the United States.

2. Jurisdiction of this Court is conferred by Section 240(a) of the Judicial Code, 28 U. S. C. § 347(a), as amended February 13, 1925 (C. 229, Sec. 1, 43 Stat. 938).

3. The court of appeals on May 28, 1945 denied a petition for rehearing of the decision of April 12, 1945.

Statement

The facts, and the nature and effect of the decision below, are sufficiently stated in the petition.

Specification of Errors

If the writ is allowed, petitioner will urge (1) that the circuit court of appeals erred in applying a supposed rule that the new use of an old instrumentality is not patentable, (2) in not determining patentability by a judgment on the question of invention, (3) in holding immaterial certain facts probative of invention, and (4) in not holding the patents valid.

Summary of Argument

The importance of review is so plain as not to need argument at length, and therefore in the argument proper we confine ourselves to an exposition of cases which sufficiently show (1) the failure below to follow the applicable decision of this Court, and (2) the conflict with decisions of the Second Circuit Court of Appeals and other courts of appeals.

Resolution of this conflict is important not simply for the usual reason that the effective administration of the law is impaired by a conflict and consequent uncertainty at any point. There is greatly added importance here because, in the exact sense in which the patents here are an instance of "new use", *every* patent for a combination of old elements is such an instance (*post*, pp. 23-24) and therefore is invalid without more if adjudicated in the Third Circuit but remains open to proof of invention and consequent validity if adjudicated elsewhere. The principle that a new combination of old elements may be patented—if *inventive*—is of such long and fixed standing,* and is the basis of such a large proportion of existing patents, that any invasion of it warrants review by this Court.

* This established principle has statutory sanction in the words "machine, manufacture" since most new machines and many manufactures are combinations of elements, each individually old; it may even be true in the case of the atomic bomb.

ARGUMENT

POINT I

The decision of the Court below is in conflict with, and failed to follow, the applicable decisions of this Court.

This Court has sustained patents which represented new uses of old things, in precisely the sense of the present patents, so it is plain without more that there is no rule such as was applied below. The two leading cases, illustrating the two types of patentable "new use" invention, are *Western Electric Co. v. LaRue*, 139 U. S. 601 and *Potts v. Creager*, 155 U. S. 597.

The absence of any preclusive rule is shown as well by cases in this Court in which patents of the same sort have been held invalid, not on a rule, but on a judgment of no invention in the conception of the new use. The decision in *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, is a demonstration of that. The decision in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 may be viewed in that light also, since it presents the same aspect of "new use" that is involved here. It too rests squarely on a judgment of no invention.

In all of these cases, whether the patent was sustained or not, this Court recognized the materiality of precisely the kind of facts that were held immaterial below. And in *Goodyear v. Ray-O-Vac Co.*, 321 U. S. 275 at 279, this Court has again affirmed the probative force of evidence that the patentee solved a problem which ordinary skill had shown it could not solve.

In *Western Electric Co. v. LaRue*, 139 U. S. 601, the patent covered an improved telegraph instrument. The improvement lay in the use of a flat torsion spring as the

mount for the key. It was claimed in combination with the key and the supports for the spring, as a combination making the improved instrument. A torsion spring had been used before in clocks and elsewhere, but in none of those uses had there been any problem or purpose analogous to that involved in a telegraph instrument. On all the evidence, the new use producing the improved instrument was held to be an invention because not plainly suggested by the former uses.

Potts v. Creager, 155 U. S. 597 illustrates another type of patentable new use, not the new combination type but the use of an entire old machine with minor structural adaptation to a new use. There the patent covered a machine for disintegrating clay, comprising a rotating drum with ribs on its surface for working on the clay, and a co-acting member against which the clay was worked by the ribs. A structure identical in all respects, except that the ribs were of glass instead of steel, had been used before for polishing wood. The patent was sustained because it was regarded as inventive to conceive that a machine of that character was the one to use for disintegrating clay.

It was expressly held that the substitution of the steel ribs for the glass ones would not itself sustain a patent if the former use had been analogous (155 U. S. at 604 and 608). The difference in problem and purpose in the former use, and the fact that the new use had escaped the efforts of the clay art to cope with its problem, were facts that were given decisive weight on the question of invention, the very facts held immaterial here.

The rule applied below would have required invalidation of the patent in each of those cases. Conversely, had these decisions been followed below, no preclusive rule would have been applied; judgment of the question of invention would have been required; and in that judgment the facts that were held immaterial below would have dem-

onstrated the inventiveness of the patented product. The conflict is direct and plain.

The case of *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464, is of especial moment here because the majority below cited it (Rec. 491) for the proposition that "the application of an old patent to a new use is not patentable". So far from making such a rule, the opinion in that case shows clearly that such a case as this must be decided by a judgment on the question of invention, which may go either way depending on the facts, especially the facts about differences in known purpose and effect and about prior efforts at solution.

The patented process there was for the preparation of a talking picture film, carrying both sound and picture on a single film, by separately exposing the sound and the picture tracks, separately developing them, and then jointly printing them on a single film for projection. In picture photography, without sound, it was known to separately expose and develop two pictures, for the *same purpose* of doing each in the best way for it, and then to print both on a single positive film, called a combination picture. The novelty of the patented process therefore was in applying to a sound-picture film the joint printing technique already known and used for the same purpose with a combination picture film. It was a "new use", in the exact sense of the term here, but it resulted in a new process in the statutory sense and so presented a question of invention.

This Court did not determine the question of patentability by invoking a preclusive "rule", to the disregard of the evidence, as did the majority below; and it expounded no such rule as that for which the majority below cited the *Paramount* case (Rec. 491). This Court proceeded to examine the question of invention. Its determinants on that question appear from the stated proposi-

tion that: "The application of an old process to a new and *closely analogous* subject matter, *plainly indicated* by the prior art as an *appropriate* subject of the process, is not invention" (*id.* 473, emphasis added).

This is the only rule. It does not preclude, but requires, a judgment on the question of invention, and it gives materiality to the facts held immaterial below.

Applying that test in the *Paramount* case, this Court found the analogy to the old combination picture to be close, when measured in terms of the problems and purposes involved; and, considering the historical evidence, it found no evidence that ordinary skill had tried and had proved unequal to the task. The conclusion therefore stood that "it required no more than the expected skill of the art of photography to use an old method of printing photographically the two negatives upon a single positive" (*id.* 473). That was a judgment on the question of invention.

POINT II

The decision of the court below is in conflict with decisions of other circuit courts of appeals, notably the Circuit Court of Appeals for the Second Circuit.

Conflicting decisions in the second circuit are the following:

Hartford v. Moore, 181 Fed. 132 (D. C.)*;

Hookless Fastener Co. v. G. E. Prentice Mfg. Co.,
68 F. 2d 940 (C. C. A. 2);

Gillman v. Stern, 114 F. 2d 28 (C. C. A. 2).

* That the law as applied in the third circuit was formerly in accord with that of the second circuit is shown by the express approval of the opinion in *Hartford v. Moore* by the Court of Appeals for the Third Circuit in *Westen Mfg. Co. v. Hartford*, 194 Fed. 875, 877. See, also, *Low v. McMaster*, 266 Fed. 518 (C. C. A. 3) and *Globe Knitting Works v. Segal*, 248 Fed. 495 (C. C. A. 3).

The proposition applied in each of these cases is that there is no rule against the patenting of a new machine or process that represents in its basic conception a new use of an old instrumentality, and that if there is any novelty of structure, whether in the form of combination with new elements (the type of *Western v. La Rue*, *Paramount v. Tri-Ergon*, and the present case) or of minor adaptation (the type of *Potts v. Creager*) the sole question is that of invention in the conception or discovery of the new use. Moreover, these cases recognize that the rule applied here by the court below would make all combinations of old elements unpatentable, and they explicitly reject that rule.

In *Hartford v. Moore*, 181 Fed. 132, the patent covered an improved shock absorber for a vehicle. It was based on the use of rotating friction surfaces which would act in either direction to modify the action of the vehicle spring, either on the bump or the recoil. These friction elements were claimed in combination with the spring. Such means had been used before to modify the action of a door spring, but acting only on one direction of spring movement, there being no rebound. Judge Hand found that it was " * * * the very kernel of the invention to select rotary friction as a suitable means of solving this problem" (*id.* 135). He said (*id.*, 136-137):

"Therefore a plausible argument may be made that the patent in suit is nothing but a new use for this old instrument without modification except that of size, which, of course, would be readily suggestible to any trained person. Yet, in spite of this similarity, I do not consider that it is a valid anticipation, because some one must have selected it for the purpose, and, as I have already said, the novelty of selection is oftentimes, a sure sign of patentable invention. * * * The device on doors was used to modify the action of a spring as it uncoiled and it had no use such as the patent in suit has. Therefore, neither the matter nor actual problem was at all similar to

that of the complainant's here, and it seems to me as much an invention to apply that kind of device to these circumstances as it was to apply the principle of friction calipers. Were not the novelty of the application a valid test of patentability, no strictly combination patent could be valid, for in all such patents each element is old, and it may be said that each element is simply applied to a new use. *Union Sugar Refining Co. v. Mathiesson*, Fed. Cas. No. 14,397; *Hailes v. Van Wormer*, 20 Wall. 353, 368, 22 L. Ed. 241; *American Tobacco Co. v. Streat*, 83 Fed. 701, 703, 28 C. C. A. 18. The formative conception of the application of old elements to a new purpose in which they are mutually interdependent requires more than a commonplace mind."

Moreover, as showing the conflict as to the materiality of the facts about prior inability to solve the problem, which the court below held immaterial here, we note the following (*id.* 137):

"Among the problems which have from the outset most troubled inventors was to modify the shocks resulting from high speed over rough roads, particularly in this country where the roads are bad. Especially was this true since the problem of spring shocks was connected with that of tires, the most difficult of all. This device has in a measure solved part of the difficulty of spring reaction, and, if the solution was obvious, why did no one of these skilled mechanics who have studied the machine inch by inch and screw by screw discover so simple a device? The pressing need for it existed for quite five years before it was discovered to the public. This is after all the best test of whether it was in the reach of the ordinary skilled artisan, and the defendant has contributed its own quota of assent to the utility of the device by what we are taught to be the sincerest commendation—a very frank imitation."

In *Hookless v. Prentice*, 68 F. 2d 940, at 941, the patent was for a combination of a well known cam lock with a

"zipper." On the particular facts of the case, it was sustained on being given the benefit of the doubt (*id.* 941). But what is significant here is the discussion of the law respecting new use. Judge Hand, speaking for the court of appeals, said (*id.* 941):

"In all such cases where the mere idea of combining old elements is the whole of the invention, we have often said that we look rather to the history of the art than to our own divinations of what was easy and apparent.

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"The defendant insists that there can be no invention in using for a new purpose a well known device; it particularly relies upon *Stearns & Co. v. Russell*, 85 F. 218 (C. C. A. 6). The dispute is one of the oldest in the patent law and the decisions so numerous, on one side and the other, that discussion of them would not be very fruitful. We conceive the rule to be that if the invention be merely of a new use for an old machine, it is never patentable; the statute does not authorize patents for uses, though **processes** come close aboard at times. But if the patent be for a new machine, there is no such doctrine, and indeed could not be, because substantially every machine is sure to be composed of old elements. The real difficulty is, as it usually is, in fixing the marches where these conflicting doctrines meet. When may one speak of a combination of elements as a 'machine'; when is such an effort abortive, in spite of an inducement such as appears in many claims; 'in a combination,' etc.; or 'in a machine for doing so and so'? Certainly such verbiage will not always avoid the objection that the patent is merely a new use; one could not get a claim for unbreakable glass in a Pullman sleeping car by beginning, 'in a communal vehicle for the dormitory accommodation of nocturnal viators,' etc. We conceive that the question in the end depends upon whether the putative unity is factitious; whether the elements can fairly be said as a whole to constitute a 'machine, manufacturer, or composition of matter.' Rev. St. § 4886

(35 U. S. C. A. § 31). There can be no doubt in this case that, so tested, the lock is only one part of a true machine, which people would think of, and use, as such. Such a canon alone can in this instance avoid the barren dialectic which pervades so much of the patent law."

Recently in *Gillman v. Stern*, 114 F. 2d. 28 at 29-30, Judge Hand applied the same proposition to a case of adaptation to a new use, of the type of *Potts v. Creager*, the patent being for a pneumatic quilting machine in which yarn was blown into pockets in the fabric by air introduced through a hollow needle having a smaller tube within it through which the yarn was fed. He said:

"The art contained nothing of the kind before except Haas' machine, of which more later. It is true, it had been common practice in many arts to introduce an air blast around the outside of a hollow tube introduced into the entrance of a larger tube through which the air escaped, and by this means to suck material from the smaller, through the larger, tube. The Venturi carbureter is an example of this; the circle of swiftly moving air entering the larger tube creates a vacuum at the end of the smaller and sucks the gasoline forward to make the mixture. The first attack upon the patent is that it was merely for a new use of an old device. However, the only objection to patenting a new use is that the statute, § 31, Title 35, U. S. Code, 35 U. S. C. A. § 31, does not include 'uses' among what can be patented, except so far as they are included within 'arts'—i. e., processes. If, however, an old article must be physically changed, even slightly, to fit the new use, it becomes itself a new 'machine' or 'manufacture,' and the statute is satisfied. In that case the only question open is whether the discovery of the new use demands enough original thought to be deemed an invention. Constitutionally only 'discoveries' can be patented at all, and the ingenuity needed for the new conception, not the amount of physical readjustment, is the test of a valuable 'discovery.'

Topliff v. Topliff, 145 U. S. 156, 163, 164, 12 S. Ct. 825, 36 L. Ed. 658; *C. & A. Potts & Co. v. Creager*, 155 U. S. 597, 608, 15 S. Ct. 194, 39 L. Ed. 275; *Rockwood v. General Fire Extinguisher Co.*, 2 Cir., 8 F. 2d. 682, 686; *Gordon Form Lathe Co. v. Walcott*, 6 Cir., 32 F. 2d. 55, 58."

Conflict exists also with decisions of other circuit courts of appeals, for in none is there any instance of decision by the rule applied below in this case. It is universal in other circuits to determine patentability by a judgment on the question of invention. Indeed, that question is commonly made decisive even when the patent presents nothing new except the use and when the principle expounded by Judge Hand would make such things unpatentable as not within the statute, without regard to inventiveness. The cases from other circuits cited in the opinion below do not support the majority's view. The following cases sufficiently show that the decisions of other courts of appeals are in conflict with that below.

Victor Cooler Door Co. v. Jamison Cold Storage Door Co., 44 F. 2d 288, C. C. A. 4, involved a patent on a factitious combination, really only a new setting for an old thing where the old instrumentality was an independent entity which performed only its usual office and had no interaction with the new setting to produce a new machine or manufacture in the statutory sense. It was disposed of however as a question of invention, none being found, in an opinion by Judge Parker which is altogether consistent with his dissenting opinion in this case. (See especially, 44 F. 2d at 294-295.)

Herman v. Youngstown, 191 Fed. 579, C. C. A. 6, sustained a patent on a new combination which represented a new use of an old instrumentality, the problem and purpose being different and not suggestive of the new use. (See especially, *idem.*, p. 582.) See also *Willett Mfg. Co. v. Root Spring Scraper Co.*, 55 F. 2d 858, 859

(C. C. A. 6). The opinion of the same court in *Standard Parts, Inc. v. Toledo, etc. Co.*, 93 F. 2d 336, at 337 (C. C. A. 6), expressly recognized that a product representing a new use may be patented if the concept of the new use is inventive. It found it not so in the case before it. Its decision was affirmed by this Court (307 U. S. 350) on the ground of no invention without considering it in the aspect of "new use".

Elsewhere, see *Standard Oil Co. v. Globe Oil & Refining Co.*, 82 F. 2d 488, 493, C. C. A. 7; *Wayne Mfg. Co. v. Benbow-Brammer Mfg. Co.*, 168 Fed. 271, 277-278, C. C. A. 8; *In re Prescott*, 71 F. 2d 162, C. C. P. A.; *In re Kylstra*, 87 F. 2d 487, C. C. P. A. and *Levin v. Coe*, 132 F. 2d 589, 595-597, C. A., D. C. The last cited case shows the generally accepted interpretation of this Court's decision in the *Paramount* case, *supra*, and is in direct conflict with the interpretation of it in this case by the court below.

Conclusion

Direct conflict has been created on a concrete point of patent law of importance and wide application. Allowance of the writ is justified.

Respectfully,

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